

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 10/662,327
Attorney Docket No. 093833-0311906 (27688-003)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Heidi L. JACQUIN *et al.*
SERIAL NO.: 10/662,327
ATTORNEY DOCKET NO.: 093833-0311906 (27688-003)
FILING DATE: September 16, 2003
ART UNIT: 3677
EXAMINER: Jack W. Lavinder
FOR: LINKABLE-SHARED FRIENDSHIP OBJECTS

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Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Further to the Notice of Appeal filed on April 14, 2005, Appellants respectfully submit Appellants' Brief on Appeal pursuant to 37 C.F.R. §41.37.

The Director is authorized to charge the \$250.00 fee for filing an Appeal Brief pursuant to 37 C.F.R. §41.20(b)(2) to Deposit Account No. 033975 (Ref. No. 093833-0311906).

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REQUIREMENTS OF 37 C.F.R. §41.37

I. REAL PARTY IN INTEREST - 37 C.F.R. §41.37(c)(1)(i)

The real party in interest is Heidi L. Jacquin by virtue of an Assignment executed on June 22, 2004, and recorded on June 23, 2004, at Reel 015495, Frame 0722.

II. RELATED APPEALS AND INTERFERENCES - 37 C.F.R. §41.37(c)(1)(ii)

Appellants are aware of no related appeals or interferences.

III. STATUS OF CLAIMS - 37 C.F.R. §41.37(c)(1)(iii)

Pending: Claims 8-9 and 17-26 are pending.

Cancelled: Claims 1-7 and 10-16 are cancelled.

Rejected: Claims 8-9 and 17-26 stand rejected.

Allowed: No claims have been allowed.

On Appeal: Claims 8-9 and 17-26 are appealed.

IV. STATUS OF AMENDMENTS - 37 C.F.R. §41.37(c)(1)(iv)

An Amendment After Final Office Action was submitted on April 14, 2005 solely to address a drawing objection. In particular, the drawings were amended to include a drawing sheet (depicting FIGS. 5A-5B). In an Advisory Action mailed April 22, 2005, the Examiner indicated that the Amendment filed April 14, 2005 will be entered.

No claims have been amended subsequent to the Final Office Action mailed December 7, 2004 (hereinafter "Final Action").

V. SUMMARY OF CLAIMED SUBJECT MATTER - 37 C.F.R. §41.37(c)(1)(v)

One aspect of Appellants' invention relates to a friendship object kit comprising at least a pair of friendship objects that may be packaged and sold together. As illustrated in FIG. 1, for example, a package (100) may include at least a pair of friendship objects (102, 104). Each of the friendship objects (102, 104) may be substantially identical or complimentary. *See Specification, e.g., pg. 5, lines 3-7; FIG. 1.* Moreover, the friendship objects can be made of a variety of materials and may comprise any one of a variety of shapes or configurations. According to one embodiment, the friendship objects may comprise plush objects such as stuffed animals, or other stuffed objects. In other embodiments, they may comprise more rigid objects. Alternatively, the objects may comprise shapes (*e.g.*, hearts or other shapes), fruits, flowers, automobiles, characters, sports-related objects, hobby-related objects, logos, mascots, or any other suitable shape. *See Specification, e.g., pg. 3, 3rd full paragraph.*

In one implementation, a first person may keep a first friendship object of the pair and give a second friendship object to a second person. *See Specification, e.g., pg. 2, 1st and 2nd full paragraphs.*

According to an embodiment, the first and second friendship objects may each comprise a connecting mechanism (106) to enable multiple friendship objects from different pairs of friendship objects to be linked together.

In one embodiment, connecting mechanism (106) may include a first connection component (106a) and a second connection component (106b). The connecting mechanism (and/or connection components) may be used to connect together or link multiple friendship objects, so that multiple friends can share and link together multiple

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friendship objects. In one embodiment, the connecting mechanism may include a jewelry clasp. For example, a first connection component (106a) of a first object may be a substantially solid ring (or other shape) and a second connection component (106b) may include a latch that can be opened, connected to the first connection component of second friendship object, and closed. In another embodiment, connecting mechanism (106) may include a hook and loop fastener material (e.g., VelcroTM). Any suitable connecting mechanism may be used such that the objects are linked together. *See Specification, e.g., pg. 5, first full paragraph;*¹ and FIGS. 1, 2A-2B, 3, and 5A-5B.²

According to an embodiment of the invention, each of the first and second friendship objects may be personalized by an audible message. In one embodiment, each of the first and second friendship objects may comprise a voice recording and playback mechanism to enable each of the first and second friendship objects to be personalized by an audible message. *See Specification, e.g., pg. 3, last full paragraph; pg. 7, last full paragraph; and FIG. 4.*

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL - 37 C.F.R. §41.37(c)(1)(vi)

1. Claim 8 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,050,695 to Fromm. *See Final Action, pg. 3, ¶'s 2-3.*
2. Claims 9 and 17-26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fromm in view of U.S. Patent No. 6,618,328 to Ellner *et al.* (“Ellner”). *See Final Action, pg. 4, ¶'s 5-8.*

¹ This paragraph was amended in the Preliminary Amendment filed March 24, 2004, and in the Amendment After Final Office Action filed April 14, 2005.

² FIGS. 5A-5B were added in the Amendment After Final Office Action filed April 14, 2005. This amendment was entered. *See 4/22/05 Advisory Action.*

VII. ARGUMENTS - 37 C.F.R. §41.37(c)(1)(vii)

The Final Action recites that claims 9 and 17-26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fromm in view of Ellner. *See* Final Action pg. 4, ¶5. It appears, however, as though the Examiner has rejected dependent claims 17-21 (which depend from independent claim 8) over Fromm in view of Official Notice, and dependent claims 22-26 (which depend from independent claim 9) over the combination of Fromm and Ellner, further in view of Official Notice. As such, Appellants have organized the following arguments accordingly.

A. Claim 8 is patentable under 35 U.S.C. §102(b) over Fromm.

The rejection of claim 8 under 35 U.S.C. §102(b) should be reversed because Fromm fails to disclose at least “*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together*” as well as the feature of “*wherein each of the first and second friendship objects is personalized by an audible message.*”

1. Fromm fails to disclose the feature of enabling multiple friendship objects from different pairs of friendship objects to be linked together.

Claim 8 recites, *inter alia*, the feature of “*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together.*” Fromm fails to disclose this feature.

Fromm appears to teach a single pair of jewelry items (e.g., first jewelry item (10) and second jewelry item (12)), wherein operation of an electrical display associated with at

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least one of the jewelry items is initiated by bringing the two jewelry items together. As illustrated in FIGS. 2-3 of Fromm, for instance, one of the jewelry items is provided with two male contacts (28, 30) while the other is provided with two corresponding female contacts (36, 38). When the male contacts (28, 30) are properly inserted into female contacts (36, 38), a circuit is completed activating a light source (18) in each of the jewelry items.

In the Final Action, at pg. 3, ¶3, the Examiner appears to rely on the contacts of Fromm to anticipate Appellants' connecting mechanism. The contacts of Fromm, however, do not enable multiple jewelry items from different pairs of jewelry items to be linked together. Particularly, Appellants note that when the single pair of jewelry items of Fromm are brought into operational contact with one another (e.g., FIGS. 4, 7, 8, 10), the male and female contacts are connected leaving the individual jewelry items with no apparent, remaining exposed contacts to enable them to be linked to other jewelry items.

Moreover, Fromm appears to teach away from enabling multiple jewelry items from different pairs of jewelry items to be linked together:

Because, in the preferred embodiment, the male and female contacts have *specific cross-sections suitable for each other, only matching finger rings can be used together* to close the normally open circuits, causing the two finger rings to become illuminated. See Fromm, col. 3, lines 20-24, *Emphasis added.*

In the Final Action, the Examiner alternatively alleges that the ring illustrated in FIG. 10 of Fromm anticipates Appellants' connecting mechanism. In particular, the Examiner recites that:

Figure 10 of Fromm discloses an embodiment with a connecting ring for connecting to a chain or rope or string. This connection ring allows multiple objects to be connected together at the same time via the rope or chain or string... See Final Action, pg. 5, ¶9.

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Appellants disagree. Nowhere does Fromm disclose, teach, or suggest that the chain (or rope or string) illustrated in FIG. 10 is used to attach half locket (15) to another piece of jewelry (e.g., another half-locket). Moreover, the Examiner's interpretation is also inconsistent with the other embodiments of Fromm wherein male and female contacts (as described above) are used to enable a single pair of jewelry items to be brought into operational contact with one another.

Further, one having skill in the art would understand that the chain (or rope or string) in Fromm to which the Examiner refers would be used to attach half locket (15) to, for example, the neck (or other body portion) of a user that is wearing the jewelry, and not to another piece of jewelry. In fact, the Examiner even appears to acknowledge as much in another portion of the Final Action (*see ¶8, pgs. 4-5*), where the Examiner recites “*...to make it easier to remove or attach the locket from or to the chain, rather than having to take the entire necklace off the user.*” ***Emphasis Added.*** In this recitation, the Examiner acknowledges that the chain (or necklace) is attached to the user.

For *at least* these reasons, Fromm fails to disclose the feature of enabling multiple jewelry items from different pairs of jewelry items to be linked together. Thus, the rejection of claim 8 is improper, and should be reversed.

2. Fromm fails to disclose the feature of each of the first and second friendship objects being personalized by an audible message.

Claim 8 further recites the feature “*wherein each of the first and second friendship objects is personalized by an audible message.*” While Fromm generally discloses (at col. 4, lines 1-8) that a device (54) may be provided which emits sound, Fromm does not disclose that sound emitted from device (54) may be personalized. In the Final Action, however, at pg. 6, ¶10, the Examiner recites:

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Fromm discloses a sound emitting device capable of emitting multiple types of audible sounds such as holiday themes like Valentine's day or Christmas or favorite song, which are considered to be personalized for the specific occasion or person. Therefore, it is believed that Fromm does disclose a device that is capable of personalizing audible sounds depending on the occasion or the person.

This is clearly incorrect. Nowhere does Fromm disclose, teach, or suggest that multiple types of audible sounds are emitted. Fromm also fails to mention the holiday themes or favorites songs alleged by the Examiner. By contrast, Fromm only recites that device (54) emits sound:

With reference now to FIG. 9, it can be seen that other forms of electrical displays may be provided in the jewelry items of this invention. For example, *a device 54 may be provided which emits sound when the magnetic switch 50 is closed*. While the sound emitting device 54 is shown with a magnetic switch, other normally open circuits may be employed which, when closed, will cause the sound emitting device to function.

See Fromm, col. 4, lines 1-8 (emphasis added).

Accordingly, because Fromm fails to disclose the feature "*wherein each of the first and second friendship objects is personalized by an audible message*," the rejection of claim 8 under 35 U.S.C. §102(b) is improper and should be reversed.

B. Dependent claims 17-21 are patentable under 35 U.S.C. §103(a) over Fromm in view of the Examiner's taking of Official Notice.

Dependent claims 17-21 are allowable because they depend from allowable independent claim 8, as well as for the further limitations they contain.

1. Claims 17-20.

In the Final Action, the Examiner takes Official Notice that the features of dependent claims 17-20 are old and well known. *See* Final Action, pg. 4, ¶'s 7-8. Appellants traverse the Examiner's invocation of Official Notice. The Examiner's assertions with regard to the features of these dependent claims are made without any

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evidentiary support. Particularly, the Examiner has failed to establish that the features of these dependent claims are known in the context of linkable, shareable friendship objects, as disclosed and claimed by Appellants. Accordingly, the rejection of claims 17-20 is improper and should be reversed.

2. Claim 21.

Dependent claim 21 furthers recite the feature of “*wherein the connecting mechanism comprises hook and loop fastener material.*” In the Final Action, at pg. 4, ¶8, the Examiner takes Official Notice that “*it is old and well known to use ... hook and loop fasteners on jewelry*” and further alleges that “*it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have replaced the ring connector on the locket in Fromm with a ... hook and loop fastener to make it easier to remove or attach the locket from or to the chain, rather than having to take the entire necklace off the user.*”

Appellants traverse the Examiner’s invocation of Official Notice. The Examiner has provided no evidence to support the contention that it is old and well known to use hook and loop fasteners (e.g., velcro) on jewelry. More particularly, the Examiner has provided no evidentiary support illustrating that it is old and well known to attach pendants, lockets, or other similar items to a chain (or necklace) via a hook and loop fastener, nor has the Examiner provided any legally proper motivation to do so. By contrast, the Examiner’s recited motivation appears to be an unsupported assertion. If a rejection under §103 is merely an unsupported assertion or mere speculation, the burden does not shift to the applicant, but rather remains on the Patent Office Examiner. *In re Donaldson*, 16 F.3d 1189, 29 U.S.P.Q.2d (BNA) 1845 (Fed. Cir. 1994). For *at least* these reasons, the rejection of claim 21 is improper, and should be reversed.

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Based on the foregoing arguments, the rejection of independent claim 8 and dependent claims 17-21 is improper and should be withdrawn.

C. Claim 9 is patentable under 35 U.S.C. §103(a) over Fromm in view of Ellner.

The Examiner legally erred in rejecting claim 9 under 35 U.S.C. §103(a) over Fromm in view of Ellner for *at least* the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

“The foundational facts for the *prima facie* case of obviousness are: (1) the scope and content of the prior art; (2) the difference between the prior art and the claimed invention; and (3) the level of ordinary skill in the art.” *In re Mayne*, 104 F.3d 1339, 1341, 41 U.S.P.Q. 2d (BNA) 1451, 1453 (Fed. Cir. 1997) (citing *Graham v. John Deere Co.*, 383 U.S. at 17-18, 86 S.Ct. at 693-94, 148 U.S.P.Q. (BNA) 459, 466-67; *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 877, 27 U.S.P.Q. 2d (BNA) 1123, 1128 (Fed. Cir. 1993)). When present, evidence of secondary considerations “must be considered in determining obviousness.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 667, 57 U.S.P.Q. 2d (BNA) 1161, 1169 (Fed. Cir. 2000).

Moreover, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. (BNA) 494, 496 (C.C.P.A. 1970).

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

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suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d (BNA) 1596, 1598-99 (Fed. Cir. 1988).

Claims 9 is patentable for *at least* the reasons that: (1) Ellner comprises non-analogous art; (2) assuming arguendo that Ellner is not deemed non-analogous, there is no legally proper teaching, suggestion, or motivation to modify Fromm to include the teachings of Ellner; and (3) assuming arguendo that there was a legally proper teaching, suggestion, or motivation to combine Fromm and Ellner, the references, even if combined, fail to disclose, teach, or suggest all of the claim elements.

1. Ellner Comprises Non-Analogous Art.

The Examiner's reliance on Ellner for the rejection of claim 9 is improper as this reference is non-analogous to Appellants' claimed invention.

A two step test has been developed to determine whether a particular reference is within the appropriate scope of the prior art. First, it must be determined whether a particular reference is "within the field of the inventor's endeavor." Second, assuming the reference is outside that field, it must be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. (BNA) 313, 315 (Fed. Cir. 1986).

a. *The references are outside Appellants' field of endeavor.*

Ellner is outside the field of the inventors' endeavor for *at least* the reason that Ellner does not relate to the relevant field of endeavor. The inventors' field of endeavor relates to friendship objects and, in particular, to two or more friendship objects that may be sold together, where one object may be kept by one person and the other may be given to a second person. Each object may have a connecting mechanism to enable multiple

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friendship objects to be linked or otherwise connected together to form jewelry, chains, or other objects. *See Specification, e.g., pg. 1, 1st full paragraph.*

Ellner explicitly recites that the field of the invention relates to "clocks, timepieces and watches, particularly but not limited to wristwatches having a watch face which is liftable off of a watch back or backing, the watch back having an outwardly facing member for performing a useful function." *See Ellner, e.g., col. 1, lines 10-15.*

This field of endeavor is not within the inventors' field of endeavor. It is not directed to linkable, shareable friendship objects and, in particular, to two or more friendship objects that may be sold together, where one object may be kept by one person and the other may be given to a second person, and where each friendship object may have a connecting mechanism to enable multiple friendship objects to be linked or otherwise connected together.

b. *Ellner is not reasonably pertinent to the particular problem(s) with which Appellants were involved.*

Since Ellner is outside the inventors' field of endeavor, the inquiry becomes whether this reference is reasonably pertinent to the particular problem(s) with which the inventors were involved. It is not.

The inventors were involved in addressing the shortcomings of known objects such as, for example, friendship bracelets, friendship rings, and charm bracelets.

Friendship bracelets, for instance, are typically given by one friend to another and worn as a symbol of friendship. Generally, each item is created and exists in isolation. *See Specification, e.g., pg. 1, 2nd full paragraph.*

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With friendship rings, each person has a single ring. When the rings are brought together, some synergistic result occurs. Such objects, however, are typically created as, and exist as, an isolated pair. *See Specification, e.g., pg. 1, 3rd full paragraph.*

With charm bracelets, each charm is usually connected to a bracelet, but not to other charms. While a first friend could give a charm to a second friend, there is typically no corresponding charm kept by the first friend. *See Specification, e.g., pg. 1, 4th full paragraph.*

Accordingly, Appellants were concerned with providing friendship objects that may be sold together, where one object may be kept by one person and the other may be given to a second person, as well as enabling multiple friendship objects (from different pairs) to be linked or otherwise connected together.

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would commend itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the inventor attempts to solve. If a reference disclosure has *the same purpose* as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. *In re Clay*, 966 F.2d 656, 23 U.S.P.Q. 2d (BNA) 1058 (Fed. Cir. 1992). *Emphasis Added.*

Ellner is more concerned with the problem of providing a watch back or backing for performing a useful function. *See Ellner, e.g., col. 2, lines 13-16.*

Ellner is not reasonably pertinent to the particular problem(s) with which Appellants were involved. The Examiner cites no evidence that a person having ordinary skill in the art would reasonably have expected to address problems that may be associated with providing linkable, shareable friendship objects by considering the problem(s)

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associated with the functionality of watch backs or backings. The record is devoid of any evidence to the contrary. As such, there would be no reason one of ordinary skill in the art would look to the diverse field of this reference absent hindsight.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would be reasonably motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor... [I]t is...in other words, common sense...in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor...The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d (BNA) 1443 (Fed. Cir. 1992).

For at least the foregoing reasons, Ellner is non-analogous to Appellants' invention, as disclosed and claimed. Any rejections based thereon should therefore be reversed.

2. There is no legally proper teaching, suggestion, or motivation to modify Fromm to include the teachings of Ellner.

Assuming arguendo that Ellner qualifies as analogous art, there is no legally proper teaching, suggestion, or motivation to modify Fromm to include the teachings of Ellner. In the Final Action, at pg. 4, ¶6, the Examiner concedes that Fromm fails to disclose "*each of the first and second friendship objects having a voice recording and playback mechanism.*" The Examiner relies on Ellner, however, for this feature. Ellner appears to disclose a timekeeping apparatus (*e.g.*, a watch) having a hidden compartment. In one embodiment, and with reference to FIG. 20, Ellner discloses that watch assembly (121) includes a timepiece (123) which includes on its rear portion and extending into or facing a secret compartment, an electronic voice chip (125) with a speaker (127). Upon the

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operation of an actuating member, an audible message can be heard through speaker (127).

A microphone assembly (129) can be provided to enable the user to put his or her own message in the timepiece. The message can be listened to and changed, as desired. *See Ellner, col. 6, lines 31-39.* The Examiner alleges, at pg. 4, ¶6 of the Final Action, that “*it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Fromm to include a recording and playback mechanism as taught by Ellner et al. in order to generate a desired message of the user.*”

The Examiner further alleges, at pg. 6, ¶12 of the Final Action, that the motivation “*is to be able to generate a desired message of the user – a further personalization of the audible sounds provided by Fromm’s device.*”

There is no legally proper teaching, suggestion, or motivation to modify Fromm to include the voice chip (125), speaker (127), and microphone assembly (129) of Ellner. As recited above, Fromm discloses a sound emitting device (54). Fromm does not, however, disclose the feature of personalizing sound emitted from device (54). As such, the Examiner’s recited motivation of “further” personalizing the audible sounds provided by Fromm’s device is without basis.

Moreover, there is no voice component to device (54) of Fromm. The Examiner has failed to identify, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, any teaching, suggestion, or motivation to modify Fromm to add voice-related features. Furthermore, the Examiner has failed to establish why one of ordinary skill in the art would look to art relating to a time-keeping apparatus for voice-related features. Accordingly, the Examiner’s rejection appears to be an exercise of hindsight based on improperly picking and choosing among disparate art

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references, with no proper suggestion for combining the relied-upon references. For at least this reason, the rejection of claim 9 is improper and should be reversed.

3. Fromm and Ellner, even when combined, fail to disclose, teach, or suggest all of the elements of claim 9.

Assuming arguendo that Fromm and Ellner could be combined, the combined references fail to disclose, teach, or suggest all of the elements of claim 9.

Specifically, the addition of Ellner does not cure the deficiencies in the disclosure of Fromm articulated in detail above concerning Fromm's failure to disclose the feature of "*the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together*" as described in detail above with regard to independent claim 8. This feature is also recited in independent claim 9. Accordingly, the rejection of claim 9 is improper and should be reversed.

For *at least* each of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, independent claim 9 is patentable over Fromm in view of Ellner.

D. Claims 22-26 are patentable under 35 U.S.C. §103(a) over the combination of Fromm and Ellner, further in view of Official Notice.

Dependent claims 22-26 are allowable because they depend from allowable independent claim 9, as well as for the further limitations they contain.

1. Claims 22-25.

The Examiner takes Official Notice that the features of dependent claims 22-25 are old and well known. *See* Final Action, pg. 4, ¶'s 7-8. Appellants traverse the Examiner's

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invocation of Official Notice for at least the reason that the Examiner's assertions with regard to the features of these dependent claims are made without any evidentiary support. In particular, the Examiner has not shown that the features of these dependent claims are known in the context of linkable, shareable friendship objects, as disclosed and claimed by Appellants. Accordingly, the rejection of claims 22-25 is improper and should be reversed.

2. Claim 26.

Dependent claim 26 further recites the feature of "*wherein the connecting mechanism comprises hook and loop fastener material.*" The Examiner takes Official Notice that "*it is old and well known to use ... hook and loop fasteners on jewelry*" and further alleges that "*it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have replaced the ring connector on the locket in Fromm with a ... hook and loop fastener to make it easier to remove or attach the locket from or to the chain, rather than having to take the entire necklace off the user.*" See Final Action, at pg. 4, ¶8.

Appellants traverse the Examiner's invocation of Official Notice. The Examiner has provided no evidence to support the contention that it is old and well known to use hook and loop fasteners (*e.g.*, velcro) on jewelry. Moreover, the Examiner has provided no evidentiary support illustrating that it is old and well known to attach pendants, lockets, or other similar items to a chain (or necklace) via a hook and loop fastener, nor has the Examiner provided any legally proper motivation to do so. By contrast, the Examiner's recited motivation appears merely to be an unsupported assertion. For *at least* these reasons, the rejection of claim 26 is improper, and should be reversed.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 10/662,327
Attorney Docket No. 093833-0311906 (27688-003)

Based on the foregoing arguments, the rejection of independent claim 9 and dependent claims 22-26 is improper and should be withdrawn.

VIII. CLAIMS APPENDIX - 37 C.F.R. §41.37(c)(1)(viii)

The pending claims (claims 8-9 and 17-26) are attached in the Appendix.

IX. EVIDENCE APPENDIX - 37 C.F.R. §41.37(c)(1)(ix)

None.

X. RELATED PROCEEDINGS INDEX - 37 C.F.R. §41.37(c)(1)(x)

None.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 10/662,327
Attorney Docket No. 093833-0311906 (27688-003)

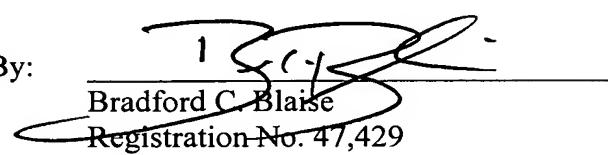
CONCLUSION

For at least the foregoing reasons, the rejection of claims 8-9 and 17-26 should be overturned and the case passed to issue.

Date: June 10, 2005

Respectfully submitted,

By:



Bradford C. Blaise
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CLAIMS APPENDIX

Claims 1-7. *Cancelled*

8. (*Previously Presented*) A friendship object kit comprising at least a pair of friendship objects that are packaged and sold together, wherein a first friendship object of the pair is for a first person to keep and a second friendship object of the pair is for a second person to receive from the first person, the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together, and wherein each of the first and second friendship objects is personalized by an audible message.

9. (*Previously Presented*) A friendship object kit comprising at least a pair of friendship objects that are packaged and sold together, wherein a first friendship object of the pair is for a first person to keep and a second friendship object of the pair is for a second person to receive from the first person, the first and second friendship objects each comprising a connecting mechanism to enable multiple friendship objects from different pairs of friendship objects to be linked together, and wherein each of the first and second friendship objects comprises a voice recording and playback mechanism to enable each of the first and second friendship objects to be personalized by an audible message.

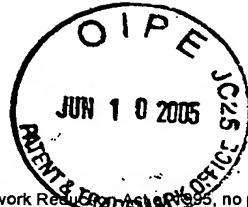
Claims 10-16. *Cancelled*

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
U.S. Application Serial No. 10/662,327
Attorney Docket No. 093833-0311906 (27688-003)

17. **(Previously Presented)** The friendship object kit of claim 8, wherein the first and second friendship objects comprise animal-shaped objects.
18. **(Previously Presented)** The friendship object kit of claim 17, wherein the first and second friendship objects comprise substantially identical animal-shaped objects.
19. **(Previously Presented)** The friendship object kit of claim 17, wherein the first and second friendship objects comprise different animal-shaped objects.
20. **(Previously Presented)** The friendship object kit of claim of claim 8, wherein the connecting mechanism comprises at least a jewelry clasp.
21. **(Previously Presented)** The friendship object kit of claim of claim 8, wherein the connecting mechanism comprises hook and loop fastener material.
22. **(Previously Presented)** The friendship object kit of claim 9, wherein the first and second friendship objects comprise animal-shaped objects.
23. **(Previously Presented)** The friendship object kit of claim 22, wherein the first and second friendship objects comprise substantially identical animal-shaped objects.
24. **(Previously Presented)** The friendship object kit of claim 22, wherein the first and second friendship objects comprise different animal-shaped objects.

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §41.37
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25. **(Previously Presented)** The friendship object kit of claim of claim 9, wherein the connecting mechanism comprises at least a jewelry clasp.
26. **(Previously Presented)** The friendship object kit of claim of claim 9, wherein the connecting mechanism comprises hook and loop fastener material.



PTO/SB/17 (12-04)

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Effective on 12/08/2004.

Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

FEE TRANSMITTAL for FY 2005

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 250)

Complete if Known	
Application Number	10/662,327
Filing Date	September 16, 2003
First Named Inventor	HEIDI L JACQUIN
Examiner Name	Jack W. Lavinder
Art Unit	3677
Attorney Docket No.	093833-0311906

METHOD OF PAYMENT (check all that apply)
 Check Credit Card Money Order None Other (please identify): _____

 Deposit Account Deposit Account Number: 033975 Deposit Account Name: Pillsbury Winthrop Shaw Pittman LLP

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

<u>Application Type</u>	<u>FILING FEES</u>		<u>SEARCH FEES</u>		<u>EXAMINATION FEES</u>		<u>Fee Paid (\$)</u>
	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	<u>Fee (\$)</u>	<u>Small Entity Fee (\$)</u>	
Utility	300	100	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEESFee Description

Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent

Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent

Multiple dependent claims

<u>Total Claims</u>	<u>Extra Claims</u>		<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>		<u>Small Entity Fee (\$)</u>
	<u>Fee (\$)</u>	<u>Fee (\$)</u>			<u>Fee (\$)</u>	<u>Fee (\$)</u>	
- 20 or HP =	X	=					

HP = highest number of total claims paid for, if greater than 20

<u>Indep. Claims</u>	<u>Extra Claims</u>		<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>		<u>Small Entity Fee (\$)</u>
	<u>Fee (\$)</u>	<u>Fee (\$)</u>			<u>Fee (\$)</u>	<u>Fee (\$)</u>	
- 3 or HP =	X	=					

HP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity)

for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
- 100 =	/50 =	(round up to a whole number)	x 125.00	=

4. OTHER FEE(S)

Non-English Specification, 130 fee (no small entity discount)

Other: Brief in support of Appeal

Fee Paid (\$)

250.00

SUBMITTED BY		Registration No. (Attorney/Agent)	Telephone
Signature	<i>Bradford C. Blaise</i>	47,429	703.905.2141
Name (Print/Type)	Bradford C. Blaise	Date	June 10, 2005

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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